

REMARKS

Disposition of Claims

Claims 3-9 are all the claims pending in the application. Claims 3-9 are rejected.

Claim Rejections Under 35 U.S.C. § 103

Claims 3-6 and 8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Gawler (U.S. Patent No. 5,683,190) in view of Oppedahl (U.S. Patent No. 7,069,247). Claims 7 and 9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Gawler and Oppedahl, and in further view of Lee (U.S. Patent No. 5,907,833). For the following reasons, Applicant respectfully traverses the Examiner's rejections.

Independent Claim 3

The Examiner has Failed to Establish a Prima Facie case of Obviousness

The MPEP states, "The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit." (MPEP § 2142, citations omitted) In the Examiner's rejection of claim 3 it is unclear which references are being applied to which elements of the claim, as well as what is and is not allegedly disclosed in each reference. For example, the rejection states, "Gawler discloses ... generating an indication of a presence of the imprint of the postal indicium in response to detection." The rejection later states, "Gawler does not expressly disclose ... generating an indication in response to detection of a transition succeeding in a predetermined number of initial transitions at a start of the sequence transaction." When the two statements are read together, it is unclear whether the Examiner is asserting that Gawler discloses generating any type of indication in response to detection.

Because of this ambiguity, Applicant submits that the rejection has failed to state a *prima facie* case of obviousness because it fails to make a clear articulation of the reasons why the claim would be obvious.

Furthermore, it is unclear how the alleged disclosures cited by the Examiner combine to cover every element of claim 3. For example, the Examiner concedes that Gawler fails to disclose “detecting a sequence of transitions between areas of light and dark reflectance with[in] the band, the band extending across the location, and generating an indication in response to detection of a transition succeeding a predetermined number of initial transitions at a start of the sequence of transitions.” (see O.A. 04/24/09, page 3, first full paragraph) Yet, the only disclosure the Examiner alleges in Oppedahl is detecting transitions between areas of light and dark reflectance within a band. Id. The Examiner never alleges that Oppedahl discloses the band extending across the location, or detection of a transition succeeding a predetermined number of initial transitions at a start of the sequence of transitions. As such, the rejection has failed to state a *prima facie* case of obviousness because it fails to make a clear articulation of the reasons why the claim would have been obvious to a person of ordinary skill in the art. The rejection does not appear to allege that each of the elements of the claim are disclosed in at least one of the cited references.

Assuming *arguendo* that the Examiner has made a *prima facie* case of obviousness, it can still be shown that the claimed invention is patentably distinguishable from the cited references.

The Prior Art References Fail to Disclose or Suggest the Claimed Invention

The second element of claim 3 recites “utilizing a sensor to scan along a band on the fed mail piece to detect a sequence of transitions between areas of light and dark reflectance within the band, the band extending across the location.” The Examiner concedes that Gawler fails to

disclose most of the claim element, but alleges that Gawler discloses “utilizing a sensor to scan along a band on the fed mail piece to detect a sequence of transitions.” (see O.A. 04/24/09, page 3, first full paragraph) It is respectfully submitted that this allegation is incorrect.

Gawler’s first presence sensor 34 detects the introduction of the mail item 20 for activating the motor 15 for feeding the mail item. (see Gawler , col. 3, lines 51-61) Gawler’s second presence sensor detects the arrival of this mail item’s leading edge for reducing the speed motors 15, 16 to a lower drive speed compatible with printing, then later senses when the mail item’s trailing edge is no longer gripped by the input rollers. (see Gawler, col. 3, lines 65-67 and col. 5, lines 39-41) Gawler makes no disclosure of utilizing a sensor to scan along a band on the fed mail piece. This deficiency, along with the Examiner’s conceded deficiencies of Gawler, show that the reference fails to disclose any aspect of the second element of claim 3.

These deficiencies are not solved by the Examiners combination of Gawler with Oppedahl. The cited portions of Oppedahl fail to disclose scanning along a band on the fed mail piece, nor a disclosure of the band extending across the location.

The third element of claim 3 recites “generating an indication of a presence of the imprint of the postal indicium in response to detection of a transition succeeding a predetermined number of initial transitions at a start of the sequence of transitions.” The Examiner alleges Gawler’s sensor 35 meets portions of this element of the invention, but this is incorrect. Gawler expressly states, “The second sensor 35 senses when the leading edge of the mail item passes the predetermined location along the feed bed and the microprocessor, in response to a signal from the sensor 35, outputs a control signal to a motor controller …” (see Gawler, col. 3, line 65 - Col. 4, line 2, emphasis added) Gawler’s sensor 35 outputs a signal in response to a leading edge of a mail piece, not in response to detection of a transition succeeding a predetermined number

of initial transitions at a start of the sequence of transitions. Furthermore, Gawler's control signal is not an indication of the presence of an imprint of a postal indicium, but a signal that the mail item is in the correct position for printing. Finally, it would be impossible for Gawler to disclose an indication of an imprint of the postal indicium because Gawler's sensor 35 is in a position upstream to Gawler's print head. (see Gawler, Fig. 1 and accompanying text)

Oppedahl fails to correct these deficiencies in the Gawler reference. The only portion of Oppedahl cited by the Examiner makes no reference to any of the aspects of this element of claim 3. While Oppedahl discloses reading bar codes, it never discloses generating an indication of the presence of an imprint of a postal indicium in response to detection of a transition succeeding a predetermined number of initial transitions at a start of the sequence of transitions, as in the present invention.

It may be that the Examiner is confused as to the nature of the claimed invention. Briefly, the invention is a method and apparatus for printing postal indicia on mail pieces which include verifying that the indicia have in fact been imprinted on the fed mail pieces. The invention avoids false indications of postal indicia by detecting a predetermined number of initial transitions prior to a transition which signals the presence of a postal indicium. The predetermined number of transitions are not due to the presence of indicia, but are from things such as the leading edge of the envelope, air mail markings, preprinted markings, and other markings or transitions possibly present on the fed mail piece. Only a transition detected after the predetermined number of initial transitions will result from, and indicate the presence of, a postal indicium on the fed mail piece. A more thorough discussion of the claimed predetermined number of initial transitions can be found in the specification (see page 7, line 18 - page 9, line

4), as well as in figure 2. The above described elements of the claimed invention are not disclosed or suggested in any of the prior art references.

For *at least* these reasons, it is submitted that claim 3 is patentably distinguished over the prior art.

Independent Claims 6 and 8

Independent claims 6 and 8 have been rejected on the same rationale as claim 3. It is submitted that claims 6 and 8 are patentably distinguished over the prior art for reasons analogous to those stated for claim 3

Dependent Claims 4 and 5

With respect to dependent claims 4 and 5, Applicant submits that they are patentable based on their dependency from claim 3.

Dependent Claim 7

With respect to dependent claim 7, Applicant submits that it is patentable based on its dependency from claim 6. Additionally, Applicant respectfully submits that the Examiner is incorrect in alleging Lee teaches or suggests stopping the feeding of further mail pieces past the print head in the event that no postal indicium is detected on the fed mail piece. First, Lee fails to disclose any detection on the fed mail pieces, and definitely does not disclose detection of indicia. The Examiner cites portions of Lee in which there is scanning of Lee's display head, not the fed mail. Lee also explicitly discloses the possibility that fed mail which receives no printed franking impression is not stopped and still passes through the photocopier. (see Lee, col. 3, lines 12-17)

Dependent Claim 9

With respect to dependent claim 9, Applicant submits that it is patentable based on its dependency from claim 8. Additionally, Lee fails to teach or suggest the second sensor as claimed. The sensor in Lee is neither configured to detect a leading edge of each fed mail piece, nor does it produce a signal to reset the counter. Instead, the sensor in Lee senses the scan light from a photocopier scanner and decrements a counter. (see Lee, col. 3, lines 42-45)

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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